

REMARKS

I. Introduction

The Final Action:

Withdraws claims 13–22 from consideration;
Makes the restriction requirement of Paper No. 9 final; and
Finally rejects claims 1–12 and 23–28 under 35 U.S.C. § 103(a).

This Response:

Notes the finality of the restriction requirement;
Amends claim 27 to cure an informality; and
Traverses all outstanding rejections.

Claim 27 is amended to correct a typographical error. No substantive amendment has been made, and no new matter has been added. The Applicants respectfully ask that this amendment be entered in accordance with 37 C.F.R. § 1.116. Claims 1–12 and 21–28 remain pending in the present application.

II. Response to the Restriction Requirement Being Made Final

The Applicants note that the Restriction Requirement of Paper No. 9 has been made final. The Applicants reserve the right to petition the Commissioner for review of this requirement, and further note that that right may be deferred until after the final action on the merits or allowance of the elected claims, but must be filed not later than an appeal.

On page 2 of the Final Action, however, the Examiner has recited a summary that does not appear to properly state the Applicants' traversal. In their Response To Restriction Requirement filed April 15, 2004 (Paper No. 10) (hereinafter the "Election"), the Applicants asserted:

[T]he Applicants respectfully remind the Examiner that M.P.E.P. § 803 requires that "if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The Restriction does not describe any serious burden that

currently impedes an examination of this application as a whole. Further, because both Group 1 and Group 2 comprise claims that have already been examined, any burden that might have existed has already been borne. Because no serious burden exists, the Applicants respectfully ask the Examiner to withdraw the restriction requirement and to continue the examination of the claims in both Group 1 and Group 2.

It was the Applicants' position that the Examiner had failed to cite a serious burden at all, not merely that the Applicants' burden is greater than the Examiner's as the summary in the Final Action appears to suggest. The Applicants again respectfully point out that no serious burden exists in the search and examination of this application as a whole. Further, even if a burden had existed, then the fact that the Examiner has already examined the withdrawn claims means that the burden of searching separate art categories has presumably already been borne. The Applicants respectfully ask the Examiner to again reconsider the Restriction Requirement and withdraw it.

III. The Rejection of Claims 1–12 and 23–28 Under 35 U.S.C. § 103(a)

The Final Action has again rejected claims 1–12 and 23–28 as obvious in light of U.S. Patent No. 5,914,068, and again refers to this patent as the “Richard” patent. U.S. Patent No. 5,914,068 is entitled “Bi-Layer Oxide Ferroelectrics,” and lists Hiratani et al. as inventors. Thus, the Applicants have assumed that the Examiner has meant to cite Richard et al., U.S. Patent No. 5,924,068 (hereinafter *Richard*), and the following arguments reflect this assumption. The Applicants respectfully assert that the Final Action has again failed to demonstrate how *Richard* can be modified to teach or suggest all of the limitations recited by claims 1-12 and 23-28.

Claim 1 recites “a speech recognition engine configured to convert spoken words associated with said file to spoken characteristics.” In the Final Action, the Examiner contends that speech recognition unit 620, *Richard* Figure 17, is a speech recognition engine as contemplated by claim 1. The Applicants respectfully disagree and point out that unit 620 is described by *Richard* as receiving voice commands and processing them as playback controls for newsreader 100. *See Richard* column 11 line 60 – column 12 line 31. Playback commands to control a device reading a file are not analogous to spoken characteristics of the

file itself, thus unit 620 can not be the speech recognition engine of claim 1. Therefore, the Applicants respectfully submit that *Richard* does not teach or suggest all of the limitations of claim 1, and respectfully ask the Examiner to withdraw the rejection.

However, even if these playback controls are deemed to be “spoken characteristics,” the rejection of record remains deficient. Specifically, if playback controls are deemed “spoken characteristics”, then *Richard* still fails to teach or disclose “a data structure” as contained in claim 1. In their response filed January 27, 2004, (hereinafter “Previous Response”), the Applicants demonstrated that the feature argued by the Examiner to be the “data structure” does not contain “spoken characteristics.” In response, the Final Action has asserted that a voice-to-text synthesized reading of a file constitutes the “spoken characteristics.” Thus, in the same rejection, the Examiner has relied on both voice-to-command elements and text-to-voice elements to be the “spoken characteristics” of claim 1. While the Applicants respectfully assert that neither of these features are the “spoken characteristics,” the Applications respectfully point out that it would be impossible for both to be the “spoken characteristics.” Therefore, the Applicants assert that *Richard* does not teach or suggest all of the limitations of claim 1, and respectfully ask the Examiner to withdraw the rejection.

Claim 7 recites “converting spoken words associated with said file into spoken characteristics associated with said file.” The Final Action contends that unit 620 performs this act of converting. However, as demonstrated above, unit 620 does not convert spoken words to spoken characteristics, unit 620 converts spoken words to playback commands. Although, even if Examiner interprets playback commands as the “spoken characteristics” of claim 7, making this assumption precludes the arguments the Examiner has made to meet the remaining limitations. Specifically, if playback commands are the “spoken characteristics,” then the examiner can no longer rely on the recitations of the text-to-voice reader to be the “spoken characteristics.” Again, while the Applicants respectfully assert that neither the voice-to-playback-commands nor the text-to-recitation elements of *Richard* are, in actuality, the “spoken characteristics” of claim 7, it is clear that both elements can not be the “spoken characteristics” at the same time. Therefore, *Richard* does not teach or suggest all of the limitation of claim 7, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Claim 23 recites “converting spoken words to spoken characteristics of said file.” As argued above, the Applicants respectfully assert that *Richard* does not teach or disclose converting spoken words to spoken characteristics, *Richard* does teach or suggest all of the limitations of claim 23. In addition, in rejecting claim 23 the Final Action opines that “speech recognition engine [unit 620] configured to convert spoken words associated with the file to spoken characteristics (170, fig 1, fig 18, text-to-speech converter, col. 12, lines 32–67 to col. 13-lines 1–60).” This argument is illogical, as it appears to contend that speech recognition unit 260 somehow produces the recitations generated by text-to-speech converter 170. Again, the Applicants respectfully assert that neither speech recognition unit 260 nor the text-to-speech converter 170 produce “spoken characteristics,” but respectfully point out that a speech recognition unit can not produce anything that is in fact generated by a text-to-speech unit. Thus, *Richard* does not teach or disclose all of the limitations of claim 23, and the Applicants respectfully ask the Examiner to withdraw this rejection.

Further, claim 23 recites “storing said content characteristics and said spoken characteristics with said file.” The Final Action does not address this limitation directly, but instead draws several inferences from the teachings of *Richard* ostensibly concluding that “Richard discloses data structure [which] associates the internal characteristics of a file and any spoken characteristics of a file.” Without conceding that the inferences drawn by the Examiner actually lead to the conclusion that *Richard* discloses a data structure that associates the internal characteristics of a file and any spoken characteristics of a file, the Applicants respectfully assert that associating internal characteristics with spoken characteristics is not the same as a storing content characteristics and spoken characteristics with said file. Therefore, *Richard* does not teach or suggest all of the limitations in claim 23, and the Applicants respectfully ask the Examiner to withdraw the rejection.

In addition, several of the inferences the Final Action draws from the teachings of *Richard* appear to be inaccurate. The Final Action cites a memory, *see* Final Action page 4, of *Richard* that purportedly stores file characteristics. The Applicants respectfully assert that the cited memory does not store file characteristics, but rather, as stated in *Richard* at col. 3, line 53, this memory stores section markers. The Final Action also cites a “linked list generator” and opines that “link lists” describe data structure. *See Final Action* page 4. Without conceding that “linked lists” are data structures as conceived by any of the pending

claims, the Applicants respectfully assert that "linked lists" are described by *Richard* as facilitating access to files, *See Richard* column 9 line 60, not as containing any characteristics of files. The Applicants, thus, respectfully assert that the inferences of the Final Action can not cure the defects of the Final Action's rejections.

Claims 1-6, 8-12, and 24-28 also stand rejected as obvious in light of *Richard*. However, each of claims 1-6, 8-12, and 24-28 depend either directly or indirectly from one of claims 1, 7, and 23. Thus each of claims 1-6, 8-12, and 24-28 inherit all of the limitations of their respective base claim. Although each of claims 1-6, 8-12, and 24-28 recite limitations that make them patentable in their own right, each is at least patentable for depending from a patentable base claim. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejections to claims 1-6, 8-12, and 24-28 as well.

IV. Conclusion

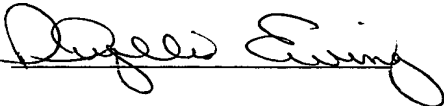
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003826-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482737630US, in an envelope addressed to: MS AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: August 27, 2004

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